

### **REMARKS**

This responds to the Office Action mailed on July 14, 2006.

No claims are amended, added, or canceled. As a result, claims 5-30 are now pending in this application.

#### **Rejection of Claims 5-8, 10, 11, 13-15, 17, 20-22, 24, and 27-29 under 35 U.S.C. §103(a) as Unpatentable over Funaki in view of Berke**

Claims 5-8, 10, 11, 13-15, 17, 20-22, 24, and 27-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Funaki (U.S. 6,689,946) in view of Berke (U.S. 6,629,094).

Funaki discloses a computer-based song-writing system for retrieving candidate words to match corresponding music (see col. 12, lines 7-28). The candidate words may be selected in part based upon the number of syllables they contain, and in part based upon the words' part of speech. It is noted that in Funaki the search engine does not retrieve from the database a unique hit, but rather the search engine may retrieve several candidate words (see col. 8, lines 44-45). Further, it will be noted that in Funaki the search engine retrieves individual words rather than a document.

Berke discloses a search engine that provides a unique hit (e.g., in the form of a web site) for each combination of a trademark and an associated product or service. (See Abstract.) However, Berke does not mention anything about "syllables".

#### ***Neither Funaki Nor Berke Disclose An Ordered Sequence of Syllable Counts***

Regarding Applicant's independent claims 5 and 27, the Examiner asserts that Funaki "receives user's input that includes an ordered sequence of number of syllables". However, an "ordered sequence of syllables counts" is definitely not shown by Funaki. Funaki receives only a number of syllables – not an "ordered sequence of syllable counts", as recited in each of Applicant's independent claims 5, 13, 20, and 27.

Applicant's FIG. 5 depicts an example of a "syllable sequence" 404, such as the syllable sequence 1, 1, 3, 1, 1, 2, 1, 1, 2. In each of Applicant's independent claims 5, 13, 20, and 27, an "ordered sequence of syllable counts" is compared with the contents of a database of analyzed documents. This is not shown anywhere in Funaki.

The Examiner, in her "Response to Arguments", quotes from Funaki (col. 1, lines 20-22). She equates Funaki's "poem piece data bank" with a searching string having an ordered sequence of syllable counts. Applicant vigorously disagrees. Col. 1, lines 20-22 of Funaki states:

"The apparatus also detects the number of syllables of a given melody so that words matching the number of syllables are derived from the 'poem piece data bank.'"

There is nothing in the quoted language that describes an ordered sequence of syllable counts. It merely discusses detecting the number of syllables (i.e. a total count, not an ordered sequence of counts) of a given melody, and finding words to match that number.

Moreover, the language referred to by the Examiner is not musically accurate. Music *per se* doesn't have syllables. Music is composed of notes of specified time duration and pitch. As best understood, the quoted language appears to refer to counting the distinct pitch changes within a given melodic fragment and then trying to match a word to that fragment.

From a careful reading of Funaki as a whole, it appears to contain no disclosure whatsoever about an "ordered sequence of syllable counts". To the contrary, Funaki describes and employs only "number of syllables" (col. 8, lines 7 and 35); "syllable number count" (col. 8, line 36); "counted number of syllables" (col. 8, lines 37-38); "two-syllable word" (col. 8, line 41); etc. Funaki only shows a syllable count and a part of speech being compared with words registered in the dictionary J, whereas in Applicant's independent claims 5, 13, 20, and 27 an "ordered sequence of syllable counts" (e.g., 1, 1, 3, 1, 1, 2, 1, 1, 2, as one example, described beginning at page 9, line 30 of Applicant's written description) is compared with the contents of a database of analyzed documents. These are very different operations. Anyone of ordinary skill in this art will appreciate that Applicant's syllable count sequence "1, 1, 3, 1, 1, 2, 1, 1, 2" is very different from Funaki's search condition consisting of a syllable count and a part of speech.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the prior art reference (or references when combined) must teach or suggest every limitation of the claim. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA, 1974). MPEP §2143.

The asserted combination of Funaki in view of Berke fails to teach or suggest all of the claim limitations present in independent claims 5, 13, 20, and 27, so a *prima facie* case of obviousness has not been established. For example, as shown above, neither Funaki nor Berke disclose an “ordered sequence of syllable counts”.

***The Examiner’s Suggested Combination of  
Funaki and Berke Would Defeat  
the Purposes of Funaki’s System***

The Examiner asserts that it would have been obvious to a person of ordinary skill in the art to apply Berke’s teaching of uniquely identifying a single web site corresponding to search criteria, by examining Funaki’s database for a unique combination stored in the database in order to save time for users reading or searching documents and to eliminate displaying irrelevant documents to a user.

Applicant respectfully traverses the Examiner’s argument. Motivation is lacking in the Funaki system to retrieve a unique word and display it to the song-writer user. The objective of the Funaki system is not necessarily to improve time efficiency, but rather it is to produce an artistic work having an aesthetic effect. This inherently requires the retrieval and display of candidate words and the song-writer user’s careful and artistic evaluation and selection of the optimum word (see col. 2, lines 29-30; col. 12, lines 21-25). In Funaki, the search result list display unit H displays a search result list (col. 9, lines 36-39), and the user selects a word from the search result list (col. 9, lines 53-56). To retrieve just a single word, as the Examiner suggests, would defeat the ability of the Funaki system to allow the individual user some artistic evaluation and to personally choose a word that he or she likes.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine them to arrive at Applicant’s claimed subject matter. The

teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. MPEP §2143.

Thus, Applicant respectfully asserts that a *prima facie* case of obviousness has not been established, because motivation to combine Funaki and Berke is lacking, since such a combination would defeat the purpose of the Funaki system.

***The Rejection of Claims 5-8, 10, 11, 13-15, 17, 20-22, 24, and 27-29  
Based Upon a Combination of  
Funaki and Berke Should be Withdrawn***

For the above reasons, independent claims 5, 13, 20, and 27 should be found to be allowable over any asserted combination of Funaki and Berke, and Applicant respectfully requests that the rejection of claims 5, 13, 20, and 27 under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Berke should be withdrawn.

Claims 6-8, 10-11, 14-15, 17, 21-22, 24 and 28-29, which depend from claims 5, 13, 20, and 27, respectively, and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above. Applicant respectfully requests that the rejection of claims 6-8, 10-11, 14-15, 17, 21-22, 24, and 28-29 under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Berke should be withdrawn.

**Rejection of Claims 9, 16, and 23  
under 35 U.S.C. §103(a) as Unpatentable  
over Funaki in view of Berke and Further in view of Erickson**

Claims 9, 16, and 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Berke and further in view of Erickson (U.S. 5,765,152).

Erickson discloses a system to provide access to copyrighted media. However, there is no mention of "syllable" in Erickson. Nor is there any mention of an "ordered sequence of syllable counts". Thus, the Examiner's suggested combination of Erickson with Funaki and Berke still fails to teach or suggest all of the claim limitations present in independent claims 5, 13, 20, and 27, so a *prima facie* case of obviousness has not been established.

Moreover, if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *MPEP* §2143.03. Independent claims 5, 13, and 20 are asserted to be patentable over Funaki in view of Berke for the reasons presented by Applicant above. Thus, claims 9, 16 and 23, which indirectly depend from claims 5, 13, and 20, respectively, and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above, and Applicant respectfully requests that the rejection of claims 9, 16 and 23 under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Berke and further in view of Erickson should be withdrawn.

**Rejection of Claims 12, 18, 19, 25, 26, and 30**  
**under 35 U.S.C. §103(a) as Unpatentable**  
**over Funaki in view of Berke and Further in view of Wu**

Claims 12, 18, 19, 25, 26, and 30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Berke and further in view of Wu (U.S. 5,991,756).

Wu discloses a search engine to retrieve documents matching a query term that may comprise a plurality of sub-terms. However, there is no mention of “syllable” in Wu. Wu also fails to disclose any “ordered sequence of syllable counts”. Thus, the Examiner’s suggested combination of Wu with Funaki and Berke still fails to teach or suggest all of the claim limitations present in independent claims 5, 13, 20, and 27, so a *prima facie* case of obviousness has not been established.

Moreover, if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *MPEP* §2143.03. Independent claims 5, 13, 20, and 27 are asserted to be patentable over Funaki in view of Berke for the reasons presented by Applicant above. Thus, claims 12, 18, 19, 25, 26, and 30, which indirectly depend from independent claims 5, 13, 20, and 27, and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above, and Applicant respectfully requests that the rejection of claims 12, 18, 19, 25, 26, and 30 under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Berke and further in view of Wu should be withdrawn.

**Additional Elements and Limitations**

Applicant considers additional elements and limitations of claims 5-30 to further distinguish over the cited references, and Applicant reserves the right to present arguments to this effect at a later date.

**Documents Cited But Not Relied Upon For This Office Action**

Applicant need not respond to the assertion of pertinence stated for the references cited but not relied upon by the Office Action, because these references are not made part of the rejections in this Office Action. Applicant is expressly not admitting to this assertion and reserves the right to address the assertion should it form part of future rejections.

**Conclusion**

Applicant respectfully submits that claims 5-30 are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, Ann M. McCrackin (located in Minneapolis, Minnesota) at (612) 349-9592 or Applicant's below-signed attorney (located in Phoenix, Arizona) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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